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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/772,197

01/29/2001

Joseph J. Sanelle

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EXAMINER

CHUNG, DAVID Y

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,197

Applicant(s)

SANELLE ET AL.

Examiner

David Y. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10 and 45, drawn to a liquid crystal display with compensation films, classified in class 349, subclass 117.
- II. Claims 13 and 14, drawn to a liquid crystal display with a heating element, classified in class 349, subclass 161.
- III. Claims 3, 4, 17, 18 and 47-51, drawn to a liquid crystal display with an electromagnetic interference shield, classified in class 349, subclass 105.
- IV. Claims 7 and 8, drawn to a liquid crystal display with anti-reflection or anti-glare means, classified in class 349, subclass 137.
- V. Claims 25-27 and 38-41, drawn to a liquid crystal display with index-matched pressure sensitive adhesive or index-matched optical bonding material, classified in class 349, subclass 122.
- VI. Claims 52-54, drawn to a liquid crystal display with a touch panel, classified in class 349, subclass 23.
- VII. Claims 31-33, 42 and 46, drawn to a liquid crystal display comprising the elements of inventions I and V.
- VIII. Claims 9, 28, 28, 34-36, 43 and 44, drawn to a liquid crystal display comprising the elements of inventions IV and V.

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- IX. Claims 19 and 20, drawn to a liquid crystal display comprising the elements of inventions II and III.
- X. Claim 21, drawn to a liquid crystal display comprising the elements of inventions II, III and V.
- XI. Claims 22-24, drawn to a liquid crystal display comprising the elements of inventions II, III, IV and V.
- XII. Claim 30, drawn to a liquid crystal display comprising the elements of inventions V and VI.
- XIII. Claim 37, drawn to drawn to a liquid crystal display comprising the elements of inventions I, V and VI.

Currently, claims 1, 2, 5, 6, 11, 12, 15 and 16 appear generic.

Inventions I, II, III, IV, V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention discloses a particular element that can be used in a liquid crystal display without being in combination with the elements of the other inventions. For example, the compensator film of invention I can be used in a liquid crystal display without the heating element of invention II, the electromagnetic interference shield of invention III, the anti-reflection film of invention IV, the adhesive of invention IV, or the touch panel of invention VI.

Inventions VII and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention I are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention I are subsequently found to be unallowable, the question of rejoinder of inventions VII and V must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention I do not set forth the details of the subcombination and the subcombination has separate utility, inventions VII and V are distinct.

Inventions VII and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention V are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention V are subsequently found to be unallowable, the question of rejoinder of inventions VII and I

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must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention V do not set forth the details of the subcombination and the subcombination has separate utility, inventions VII and I are distinct.

Inventions VIII and IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention V are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention V are subsequently found to be unallowable, the question of rejoinder of inventions VIII and IV must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention V do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and IV are distinct.

Inventions VIII and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

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particulars of the subcombination as the claims of invention IV are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IV are subsequently found to be unallowable, the question of rejoinder of inventions VIII and V must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention IV do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and V are distinct.

Inventions IX and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention III are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention III are subsequently found to be unallowable, the question of rejoinder of inventions IX and II must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions IX and II are distinct.

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Inventions IX and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention II are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention II are subsequently found to be unallowable, the question of rejoinder of inventions IX and III must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention II do not set forth the details of the subcombination and the subcombination has separate utility, inventions IX and III are distinct.

Inventions X and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention IX are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IX are subsequently found to be unallowable, the question of rejoinder of inventions X and V

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must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention IX do not set forth the details of the subcombination and the subcombination has separate utility, inventions X and V are distinct.

Inventions X and IX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention V are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention V are subsequently found to be unallowable, the question of rejoinder of inventions X and IX must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention V do not set forth the details of the subcombination and the subcombination has separate utility, inventions X and IX are distinct.

Inventions XI and VIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed

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does not require the particulars of the subcombination as the claims of invention IX are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IX are subsequently found to be unallowable, the question of rejoinder of inventions XI and VIII must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention IX do not set forth the details of the subcombination and the subcombination has separate utility, inventions XI and VIII are distinct.

Inventions XI and IX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VIII are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VIII are subsequently found to be unallowable, the question of rejoinder of inventions XI and IX must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention VIII do not set forth the details of the subcombination and the subcombination has separate utility, inventions XI and IX are distinct.

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Inventions XII and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VI are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VI are subsequently found to be unallowable, the question of rejoinder of inventions XII and V must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention VI do not set forth the details of the subcombination and the subcombination has separate utility, inventions XII and V are distinct.

Inventions XII and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention V are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention V are subsequently found to be unallowable, the question of rejoinder of inventions XII and VI

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must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention V do not set forth the details of the subcombination and the subcombination has separate utility, inventions XII and VI are distinct.

Inventions XIII and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention XII are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention XII are subsequently found to be unallowable, the question of rejoinder of inventions XIII and I must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention XII do not set forth the details of the subcombination and the subcombination has separate utility, inventions XIII and I are distinct.

Inventions XIII and XII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed

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does not require the particulars of the subcombination as the claims of invention I are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention I are subsequently found to be unallowable, the question of rejoinder of inventions XIII and XII must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention I do not set forth the details of the subcombination and the subcombination has separate utility, inventions XIII and XII are distinct.

Inventions XIII and VI are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VII are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VII are subsequently found to be unallowable, the question of rejoinder of inventions XIII and VI must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention VII do not set forth the details of the subcombination and the subcombination has separate utility, inventions XIII and VI are distinct.

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Inventions XIII and VII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VI are evidence claims which indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VI are subsequently found to be unallowable, the question of rejoinder of inventions XIII and VII must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention VI do not set forth the details of the subcombination and the subcombination has separate utility, inventions XIII and VII are distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Chung whose telephone number is (703) 306-0155. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:00 pm.


TOANTON
PRIMARY EXAMINER

David Chung
GAU 2871
02/27/03